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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,167	05/29/2007	Ian John Keen	08364.0087	1854
22852 7590 03/01/2010 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER MARSHALL, CHRISTLE I	
			ART UNIT 2887	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/582,167	Applicant(s) KEEN ET AL.	
	Examiner Christle I. Marshall	Art Unit 2887	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/29/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Receipt is acknowledged of applicant's amendment filed on June 8, 2006.

Claims 1-22 have been canceled without prejudice. Claims 23-43 have been added.

Claims 23-43 are pending and an action on the merits is as follows.

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). However, the newly claimed features, which examiner acknowledges as being supported in the specifications of the application and is not new matter, is not supported in either specification of the foreign applications, therefore the prior art for the newly claimed features need only meet the effective filing date (December, 8 2004) of the application.

Claim Objections

1. Claims 33 and 40 are objected to because of the following informalities: claim 33 currently depends on claim 31, however , claim 31 lacks an antecedent basis for "the number of times the identification data communicated to the data storage device" which is introduced in claim 32; claim 40 line 4 has "portable storage device when the portable

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communication device" which should be --portable user device when the portable user device-- for claim language consistency. Appropriate correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 41 and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Eakin (US 20050079859).

Eakin discloses a data storage device (516) for wirelessly communicating with a reader (216) of a portable user device (102) to enable data to be read from the data storage device, the device comprising: a communicator operable to enable wireless communication with a reader to enable receipt of a reader signal and to enable communication of data between the device and the reader (528), wherein the device is initially arranged to communicate with different readers (502, 504, 506) and, in response to receipt of a reader signal from a particular reader or readers (518, 522, 520), is subsequently arranged to communicate with that reader or those readers (par 47); wherein the reader signal comprises identification data that enables a user of the

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portable user device to control the readers that can read data from the data storage device (par 54-56).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 23-31, 37, 39, 40, 43** are rejected under 35 U.S.C. 103(a) as being unpatentable over Eakin (US 20050079859) in view of Milstein et al (US 20050229036).

Re claims 23, 40, and 43, Eakin discloses a communications system (100, 500) comprising: a data storage device (126, 516) comprising a store storing data (218, 508-512); and a portable user device configured to communicate over a telecommunications network (102, 502-506) and incorporating a reader configured to communicate wirelessly with the data storage device (216), the portable user device being configured to provide identification data and the reader being configured to communicate a signal

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comprising the identification data wirelessly to the data storage device (ID 210), and the data storage device having an identification data storer storing identification data (234, 538), an extractor operable to extract identification data from a signal received from the reader, a comparator operable to compare the extracted identification data with identification data stored in the identification data store of the data storage device and a controller operable to download data stored in the store to the reader of the portable user device in the event the extracted identification data enables downloading of that data (par 34-35, 18-26).

Eakin fails to disclose a reader configured to communicate wirelessly with the data storage device when the portable communications device comes within range of the data storage device to cause a user interface of the portable user device to issue a message to the user asking whether or not the user wishes to download data from the data storage device, and the portable user device being configured to provide identification data when the user indicates that they wish to download the data.

However, Milstein teaches a portable device wishing to communicate with a storage device sensed nearby will prompt the user to initiate data transfer from the storage device by notifying the storage device of its “trusted device” status (par 14, 23, 25, 29-31).

Given the teachings of Milstein, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Eakin with a reader configured to communicate wirelessly with the data storage device when the portable communications device comes within range of the data storage device to

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cause a user interface of the portable user device to issue a message to the user asking whether or not the user wishes to download data from the data storage device, and the portable user device being configured to provide identification data when the user indicates that they wish to download the data.

Doing so would allow the user to monitor when data from the nearby storage device should be transferred, preventing automatic communication of information without the user knowing.

Re claims 24-31, 37, 39, Eakin as modified by Milstein discloses the identification data store comprises a write only memory portion (code 236 of memory 230); an enabler operable to enable writing of identification data communicated to the data storage device by the reader to the identification data store (processor 226 writing code 236, par 38-39); the enabler is operable to enable writing of identification data to the identification data store in at least one of the following circumstances: 1) there is no identification data stored in the identification data store (code 236 par 38-39); and 2) in accordance with the outcome of the comparison carried out by the comparator; the controller is operable, in accordance with the result of a comparison by the comparator of obtained identification data with stored identification data, to enable the user of the portable user device to change or supplement the identification data stored by the identification data store to control the readers that can read data from the data storage device (par 56 user adding new device); the identification data store is configured to be writable to only once for storing identification data (Milstein: ROM par 12, 17); the identification data comprises at least one PIN code (par 35); the extractor is operable to

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extract a plurality of PIN codes, the comparator is operable to compare a plurality of PIN codes and the controller is operable to control operation of the data storage device in accordance with the outcome of the comparisons carried out by the comparator (par 35, 49-52); the identification data store comprises a plurality of storage portions (508 -512), each storage portion being associated with different identification data, and wherein the data storage device is operable to permit access to each storage portion of the identification data store on the basis of corresponding identification data extracted by the extractor so as to control operation of the data storage device (par 49-54); the data storage device is operable to communicate data to a reader by modulating the reader signal (224, par 30); the portable user device is configured to communicate with a service provider via the telecommunications network to obtain the identification data when the user indicates that they wish to download the data (tower 124, par 21-23, 26).

Claims 32-34, 36, 38 rejected under 35 U.S.C. 103(a) as being unpatentable over Eakin as modified by Milstein, and further in view of Takemura et al (US 20040250037).

Eakin's invention as modified by Milstein, discloses all of the claimed limitations from above except for the controller further comprises a determiner operable to determine the number of times the identification data communicated to the data storage device does not have a predefined relationship with identification data stored by the identification data store; the controller further comprises a locker operable to lock the data storage device in a disabled state in the event that the number of times the

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identification data communicated to the data storage device does not have a predefined relationship with identification data stored by the identification data store reaches a predetermined number; the controller is arranged to unlock the data storage device from a disabled state in the event predetermined identification information is communicated to the data storage device; the data storage device further comprises a power supply deriver operable to derive a power supply from a reader signal to enable operation of the data storage device; the data storage device and reader are configured to communicate by radio frequency communication and primarily by inductive coupling.

However, Takemura teaches a system with an IC card and reader, where either is implemented in a computer or mobile phone, where the reader transmits power and information by electromagnetic induction to the IC card (par 6, 10), the information includes a PIN code used to access data in the IC card. When a wrong code is input, a record is generated to tally until it reaches a maximum number of wrong entries, at that point the card will lock, and once that number is reset and a correct code is received the data is unlocked (par 102-119).

Given the teachings of Takemura, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the system of Eakin as modified by Milstein with a determiner operable to determine the number of times the identification data communicated to the data storage device does not have a predefined relationship with identification data stored by the identification data store; a locker operable to lock the data storage device in a disabled state in the event that the number of times the identification data communicated to the data storage device does not have

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a predefined relationship with identification data stored by the identification data store reaches a predetermined number; unlock the data storage device from a disabled state in the event predetermined identification information is communicated to the data storage device; the data storage device further comprises a power supply driver operable to derive a power supply from a reader signal to enable operation of the data storage device; the data storage device and reader are configured to communicate by radio frequency communication and primarily by inductive coupling.

Doing so would allow the data storage device to be driven by the supplied power so as to respond to the signal communicated by the reader, and the access limit prevent a malicious user from trying to provide too many identification data signals so as to protect the data.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eakin as modified by Milstein, and further in view of Chen (US 7461264).

Eakin's invention as modified by Milstein, discloses all of the claimed limitations from above except for the controller further comprises an eraser operable to erase at least some of the data stored by the store in the event the determined number reaches a set number.

However, Chen teaches there is a limit to how many times an attempted access to the data can be and after that limit the attempts are rejected or internal confidential data is deleted. (col. 5 ln. 20- col. 6 ln. 12, Fig 7).

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Given the teachings of Chen, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the system of Eakin as modified by Milstein with an eraser operable to erase at least some of the data stored by the store in the event the determined number reaches a set number.

Doing so would prevent unauthorized access to confidential data in the storage.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christle I. Marshall whose telephone number is (571) 270-3086. The examiner can normally be reached on Monday – Friday 6:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Paik can be reached on (571) 272-2404. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. I. M./

Examiner, Art Unit 2887

/Seung H Lee/

Primary Examiner, Art Unit 2887